

Application Number 10/016,507
Amendment dated March 28, 2005
Responsive to Office Action mailed December 28, 2004

REMARKS

This submission is responsive to the Office Action dated December 28, 2004. Claims 1, 2, 4-18, 20-26, 28-42 and 44-64 are pending.

Claim Rejections Under 35 U.S.C. § 102 and § 103

In the Office Action, the Examiner rejected claims 1, 2, 5 and 13 under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent No. 6,283,761 to Joao (Joao '671). Applicant respectfully traverses these rejections. The Joao '671 patent fails to disclose each and every feature of the claimed invention and provides no teaching that would have suggested the desirability of modification to include such features.

Claim 1 is directed to a system for communicating medical information, comprising a medical device installed with a version of software, and a software agent communicatively coupled to the medical device for interacting with the medical device, wherein the software agent interacts with the medical device irrespective of correspondence with the version of software installed on the medical device.

In contrast, the Joao '761 patent is directed to the creation and management of a comprehensive healthcare processing system for processing and/or providing healthcare information for a variety of healthcare and healthcare related applications. The Joao '761 system includes a plurality of computers, such as a central computer(s), provider computer(s), payer computer(s), patient computer(s), and/or intermediary computers which may communicate with and/or share data and information with each other. The "computers" which may be included in the Joao '761 system include personal computers, laptop computers, PDAs, cell phones, televisions, beepers, pagers, or watches (see, e.g., Joao '761 at column 14, line 48-48).

The Joao '761 patent fails to disclose each and every feature of the claimed invention and provides no teaching that would have suggested the desirability of modification to include such features. For example, Joao '761 fails to teach or suggest a system for communicating medical information that includes a medical device, as recited by Applicant's claim 1. Moreover, Joao '761 fails to teach or suggest a software agent communicatively coupled with the medical device, wherein the software agent interacts with the medical device irrespective of correspondence with

Application Number 10/016,507
Amendment dated March 28, 2005
Responsive to Office Action mailed December 28, 2004

the version of software installed on the medical device, as recited by Applicant's claim 1. In fact, Joao '761 does not mention, teach or suggest either of these limitations of claim 1 at all.

The Examiner admits that the Joao '761 patent is entirely silent concerning communication irrespective of correspondence with the version of software installed on the medical device. Namely, the Examiner writes that "No statement is made in the Joao patent that would inhibit the software agent from interacting with other/different versions of the computer's operating system."

Applicant respectfully submits that this statement is entirely inadequate to support a rejection under either 35 U.S.C. 102(e) or 35 U.S.C. 103(a). The fact that a reference doesn't say that it could not perform a claimed limitation is entirely different from actually teaching or suggesting that claimed limitation. In this case, the Joao '761 patent is completely silent concerning presence of a medical device, and is also completely silent concerning a software agent that interacts with the medical device irrespective of correspondence with the version of software installed on the medical device. A reference's silence concerning specific claim limitations does not support a rejection under either 35 U.S.C. 102 or 35 U.S.C. 103. Rather, in the absence of a specific teaching or suggestion of each and every claim limitation, the claim should be allowed.

In order to support an anticipation rejection under 35 U.S.C. 102(e), it is well established that a prior art reference must disclose each and every element of a claim. If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. 102(e) is improper. Joao '761 fails to disclose each and every limitation set forth in claims 1, 2, 5 and 13. For at least these reasons, the Examiner has failed to establish a prima facie case for anticipation of Applicant's claims 1, 2, 5 and 13 under 35 U.S.C. 102(e). Withdrawal of this rejection is requested.

As per the obviousness rejection under 35 U.S.C. 103(a), it is well established that the Examiner bears the burden of establishing a prima facie case of obviousness.¹ In doing so, the Examiner must determine whether the prior art provides a "teaching or suggestion to one of

¹ *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Application Number 10/016,507
Amendment dated March 28, 2005
Responsive to Office Action mailed December 28, 2004

ordinary skill in the art to make the changes that would produce" the claimed invention.² A prima facie case of obviousness is established only when this burden is met.

The Court of Appeals for the Federal Circuit recently addressed the evidentiary standard required to uphold an obviousness rejection.³ Specifically, the Federal Circuit stated: "[the] factual question of motivation is material to patentability, and (can) not be resolved on subjective belief and unknown authority.⁴ This finding must be based upon substantial evidence, and not subjective musings or conjecture by the Examiner.⁵ Deficiencies in the evidentiary record cannot be cured by general conclusions such as "general knowledge" or "common sense."⁶ Accordingly, the Examiner cannot rely on unsupported, conclusory statements to close holes in the evidentiary record.⁷ Unless the Examiner can establish an evidentiary record based on concrete prior art references that establish that it would have been obvious to a person with ordinary skill in the art to incorporate the features of Applicant's claims within the system described by Joao, the claims should be allowed.

The conclusion of obviousness is therefore improper for several reasons. As discussed above, the Joao '761 patent does not teach either a medical device or a software agent that interacts with the medical device irrespective of correspondence with the version of software installed in the medical device. The Examiner cited no prior art teaching suggesting the desirability of modifying the Joao '761 system to include communication with a medical device. Moreover, the Examiner failed to explain why one of ordinary skill in the art would have considered it desirable to modify the Joao '761 system to include a software agent that interacts with a medical device irrespective of correspondence with the version of software installed on the medical device. As discussed above, the Joao '761 reference is not at all concerned with this problem, nor does it address, teach or suggest any possible solutions to the problem, much less the system recited in Applicant's claim 1. The Examiner has not provided a reference that

² *In re Chu*, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995).

³ *In re Lee*, 61 USPQ2d 1430, (CAFC 2002).

⁴ *Id.* at 1434.

⁵ *Id.*

⁶ *Id.*

⁷ *Id.*

Application Number 10/016,507
Amendment dated March 28, 2005
Responsive to Office Action mailed December 28, 2004

substantiates the existence of such features in other systems at the time of Applicant's filing, much less evidentiary support of motivation to combine this feature into the system of the Joao '761 patent. Applicant therefore respectfully requests that the rejection under 35 U.S.C. §103(a) be withdrawn.

Allowable Subject Matter

In the Office Action, the Examiner indicated that claims 8, 14-18, 20-26, 28-42, 44-58 and 62-64 are allowable in their present form. Claims 4, 6, 7, 9-12 and 59-61 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As discussed above, claim 1 is allowable over the prior art of record. Consequently, claims 4, 6, 7, 9-12 and 59-61, because they are dependent upon claim 1, are also in condition for allowance.

CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

March 28, 2005
SHUMAKER & SIEFFERT, P.A.
8425 Seasons Parkway, Suite 105
St. Paul, Minnesota 55125
Telephone: 651.735.1100
Facsimile: 651.735.1102

By:

Kari H. Bartingale
Name: Kari H. Bartingale
Reg. No.: 35,183